

### **REMARKS**

The Action mailed on November 15, 2005 rejects claims 1-3, 5-18, 22, 23, and 32 under 35 USC § 103(a) as being unpatentable over US Patent 6,717,573 (hereinafter referred to as "Shahoian"), in view of US Patent 6,525,749 (hereinafter referred to as "Moran"). Applicant amends claims 14, 18, and 23 to more clearly set forth the subject matter intended to be claimed, and cancel claim 16. No new matter is added.

Independent claim 1 is rejected over a combination of Shahoian and Moran under 35 U.S.C. 103(a). To make such a rejection, an examiner must provide objective evidence of a suggestion or motivation in the art to combine the references. MPEP § 2142. As further recited in MPEP § 2145, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings." See also, *In re Fitch* 972 F.2d 1260, 1265 (Fed.Cir.1992) ("the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references'"). Moreover, the Board of Patent Appeals has noted on a number of occasions, including in *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (1992), for evidence of a motivation to combine references to be sufficient to form the basis of an obviousness rejection, the evidence would have to "impel one skilled in the art to do what the patent applicant has done." As the Board and the courts have repeatedly held, such evidence is essential to avoid the impermissible use of hindsight, using "that which only the inventor taught [] against the teacher." See *In re Dembiczak*, 175 F.3d 994 (quoting *W.L. Gore & Assoc., Inc v. Garlock, Inc.* 721 F.2d 1540, 1553).

To justify the combination of the references, the Action merely states that

it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the gesture as taught by Moran in the haptic mouse disclosed by Shahoian because this would provide a system including a data interface surface and user controllable means for generating information on said surface."

This statement fails to include any objective evidence that a suggestion or motivation to combine the references existed at the time of the invention of the subject matter by the Applicant.

Furthermore, even if the motivation asserted in the Action existed in the art at that time, Applicants submit that such a motivation would be insufficient to impel one skilled in the art to combine the references, as is required to maintain an obviousness rejection. As such, Applicants must assume that the motivation asserted in the action was derived based on impermissible hindsight.

Thus, Applicant requests reconsideration and withdrawal of the § 103 rejection of independent claim 1. Claims 2, 3, 5-18, 22, 23, and 32 depend from independent claim 1, either directly or indirectly, and add further limitations thereto. Applicants therefore request reconsideration and withdrawal of the § 103 rejection of these claims, as well. If the Examiner intends to maintain the rejection, Applicant requests that any subsequent action include specific citation to portions within either reference that provide a suggestion or motivation to combine the references, or alternatively, provide other factual evidence substantiating that the asserted motivation or suggestion existed at the time of invention.

In addition to reasons set forth above, dependent claim 9 patentably distinguishes over the combination of Shahoian and Moran because neither reference teaches or suggests a command for flipping a page, as recited in the claim. In rejecting claim 9, the action asserts that Shahoian describes such a command at column 19, lines 59–62. Lines 59–62 of column 19 states, “The user typically controls a cursor 400 to select and/or manipulate graphical objects and information in the graphical user interface.” This passage in no way describes a command for flipping a page. Thus Applicants request reconsideration and withdrawal of the §103 rejection of 9 on these grounds, as well.

Similarly, claim 22 recites a command for altering a transparency characteristic of an image in now cancelled claim 22. Neither Shahoian or Moran teach or suggest such a command. In rejecting claim 22, the action asserts that Moran describes such a command at column 8, lines 10–13. This passage relates a user interface having a transparent drawing surface for accepting commands. The passage does not describe a command that alters the transparency of an image. Yet this is the explicit subject matter of claim 22. Thus, in addition to the reasons set forth above with respect to independent claim 1, Applicant requests reconsideration of claim 22 on these grounds, as well.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. PGLD-P01-003 from which the undersigned is authorized to draw.

Dated: 

Respectfully submitted,

By \_\_\_\_\_  
Edward A. Gordon  
Registration No.: 54,130  
ROPES & GRAY LLP  
One International Place  
Boston, Massachusetts 02110-2624  
(617) 951-7000  
(617) 951-7050 (Fax)  
Attorneys/Agents For Applicant